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10/584,682

06/28/2006

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EXAMINER

FLETCHER III, WILLIAM P

ART UNIT

PAPER NUMBER

1717

MAIL DATE

DELIVERY MODE

08/30/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/584,682

Applicant(s)

HASS ET AL.

Examiner

WILLIAM PHILLIP FLETCHER III

Art Unit

1717

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 1-111 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☒ Claim(s) 1-106 and 109-111 is/are allowed.
- 7) ☒ Claim(s) 107 and 108 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-943)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Response to Amendment

1. The amendment and remarks filed on 16 June 2011 are noted with appreciation.
2. Claims 1-111 remain pending.

Response to Arguments

3. Applicants arguments have been considered. The rejections set forth in the prior Office action, for all claims except 107 & 108, are withdrawn. The closest prior art was cited in the prior Office action, and requires a moving rather than a stationary substrate as now claimed.

4. Claims 107 & 108 are product-by-process claims. Reference is made to MPEP §2113. A product-by-process claims are not limited by the manipulations of the recited steps, only the structure implied by the steps. In the instant case, Applicant has summarized the only difference between the cited prior art and the instant claims, as amended: "The claimed invention requires, *inter alia*, deflecting an evaporated vapor flux by a carrier gas stream into an interior of a stationary substrate from an area distal from and external to the substrate. ...Contrary to the claimed invention, Henshaw discloses a deposition method wherein a cylindrical substrate must be swept over a stationary cathode-anode gap from which a stream of metal atoms is emanating through an opening in a hollow cathode." In other words, the distinguishing feature of the claimed method and apparatus is that the substrate is stationary and does not move. Within the context of MPEP §2113, it is the Primary Examiner's position that the resultant article is the same – an interiorly-coated article -- regardless of whether the

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substrate is moved or not. One a product appearing to be substantially identical is found, and a rejection made, the burden shifts to Applicant to show an unobvious difference.

Claim Rejections - 35 USC § 102

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 107 & 108 remain rejected under 35 U.S.C. 102(b) as being anticipated by Henshaw et al. (US 4,407,712 A).

7. These claims remain rejected for the same reasons set forth in the prior Office action and as further explained above.

Allowable Subject Matter

8. Claims 1-106 and 109-111 are allowed.

9. The following is a statement of reasons for the indication of allowable subject matter: The closest prior art is of record; it neither teaches nor suggests a stationary substrate and gas streams directed from an area distal from and external to said stationary substrate.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM PHILLIP FLETCHER III whose telephone number is (571)272-1419. The examiner can normally be reached on Monday through Friday, 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dah-Wei Yuan can be reached on (571) 272-1295. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/WILLIAM PHILLIP FLETCHER III/
Primary Examiner, Art Unit 1717

25 August 2011